

REMARKS

The claims presently pending in the application are claims 1-20. No amendments are presented in this response.

DECISION REGARDING DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1.131

In the Office Action dated October 14, 2008, the Examiner asserted that the Declaration filed under 37 CFR 1.131 was ineffective to overcome the Kumar reference because the “affidavit does not provide factual evidence for proof of actual reduction to practice or diligence.”

The declarations submitted on June 23, 2008 included:

- 1) Supplemental Declaration of Prior Invention under 37 C.F.R. § 1.131 filed in this application and signed on June 23, 2008 (the “Peterson Declaration of June 23, 2008”); and
- 2) corroborating Declaration of Robert P. Catalano filed in this application and signed on June 23, 2008, including RPC Exhibits A-1 through A-7 (the “Catalano Declaration of June 23, 2008”).

It is respectfully submitted that the proof submitted on June 23, 2008, including complete disclosure to another (disclosure of the invention to Robert P. Catalano, reduction to practice under the inventor’s direction by Mr. Catalano of a working prototype no later than November 2002, demonstration to a potential customer on December 12, 2002) was indeed factual evidence for proof of actual reduction to practice prior to the effective date of the Kumar reference on December 16, 2002. Notwithstanding, Applicant is providing herein additional details regarding the actual reduction to practice prior to the effective date of Kumar.

REJECTION OF THE CLAIMS UNDER 35 U.S.C. §103(a)

Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kumar et al. U.S. Patent Publication No. 2006/0100912A1 (“Kumar”) filed as PCT/US03/39972 on December 16, 2003 and claiming priority to provisional application number 60/433,597 filed on December 16, 2002, in view of Ram et al. U.S. Patent Publication No. 2003/0009411A1 (“Ram”).

APPLICANT'S RESPONSE TO THE REJECTION OF THE CLAIMS UNDER 35 U.S.C. §103(a)

These rejections are respectfully traversed, and reconsideration of claims 1-20 is respectfully requested in light of the remarks which follow, and the additional new testimonial and documentary evidence contained in the accompanying supporting documents. The documents submitted with this response include:

1. Supplemental Declaration of Prior Invention Under 37 C.F.R. § 1.131, signed by Gary E. Peterson on March 10, 2009 (the “Peterson Declaration of March 10, 2009”);
2. Corroborating Declaration of Robert P. Catalano signed by Robert P. Catalano on March 10, 2009 (the “Catalano Declaration of March 10, 2009”);
3. Corroborating Declaration of Robert van Eyck signed March 3, 2009 (the “van Eyck Declaration”);
4. Corroborating Declaration of Oliver d’Oelsnitz signed March 5, 2009 (the “d’Oelsnitz Declaration”);
5. A true color copy of the visual display referenced in the Peterson Declaration of March 10, 2009, and the Catalano Declaration of March 10, 2009, and included in the Catalano Declaration of June 23, 2008 as RPC Exhibit A-1.

Identification of the Declarants

The relationship, if any, to the real party in interest in the present application, of the individuals whose declarations are attached (and in some cases previously submitted in connection with this and related applications 10/868,484 and 11/223,468) are set forth in their respective declarations. To facilitate the Examiner’s review, we are providing the following brief statement regarding the witnesses:

1. Gary E. Peterson (inventor); was at the relevant time, and is currently, an officer of IMAG Inc., the assignee and real party in interest;

2. Robert P. Catalano (corroborating witness); was at the relevant time a full-time employee of IMAG Inc.; worked under the direction of the inventor to develop the software that reduced the invention to practice;
3. Robert van Eyck (corroborating witness); was at the relevant time a full-time employee of IMAG Inc.; took employment elsewhere in 2007; retains a small equity interest in IMAG Inc.; and
4. Oliver d'Oelsnitz (corroborating witness); was at the relevant time employed by a customer of IMAG Inc.; witnessed the first commercial demonstration of the invention.

Review of the Legal Standard Applicable to Evidence of Prior Invention

The Standards under 37 C.F.R. § 1.131(b)

37 C.F.R. § 1.131(b) requires that:

“The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.”

A leading authority that interpreted the requirements of this showing of facts under 37 C.F.R. § 1.131(b) was decided over 40 years ago by the United States Court of Customs and Patent Appeals in the decision rendered *In re Harry*, 51 C.C.P.A. 1541, 333 F.2d 920, 142 U.S.P.Q. 164 (1964). In that case, the Court determined that affidavits submitted were not adequate, because the affidavits did not constitute proof or a “showing of facts” as required by 37 CFR § 1.131(b), but “mere pleading.” The court stated that the affidavits “asserted that facts exist but does not tell what they are or when they occurred.” 333 F.2d at 922. Applicant respectfully submits that the showing of facts in the Peterson Declaration of March 10, 2009, the additional corroborating Catalano Declaration of March 10, 2009, the corroborating van Eyck Declaration, and the corroborating d’Oelsnitz Declaration all clearly state the relevant facts, why they are

relevant, and when they occurred, in great detail, that are evidence of an actual reduction to practice prior to the earliest filing date on December 16, 2002 of the Kumar reference relied upon in the § 103(a) rejection.

The allegations of fact set forth *may* be supported by various types of evidence, including one or more of sketches, notebook entries, or attached supporting statements by witnesses. It is noteworthy that in the context of the latter, the MPEP cites *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). In that case, the Board of Patent Appeals and Interferences reversed the Examiner's rejection and refusal to accept the declarations under 37 C.F.R. § 1.131. The Examiner only considered the written notes, and indicated that those notes were insufficient to allege conception. The reversal was based on the Board of Patent Appeals and Interferences determination that "(1) all the evidence must be considered in its entirety, including the Rule 131 declarations and accompanying exhibits, records and "notes", (2) an accompanying exhibit need not support all of the claimed limitations but rather a missing feature may be supplied by the declaration itself. *Ex parte Swaney*, 89 USPQ 618 (PO Bd.App.1950), and (3) it is entirely appropriate for appellants to rely on a showing of facts set forth in the Rule 131 declarations themselves to establish conception of the invention prior to the effective date of the reference." 10 USPQ2d, 1077.

The standard in the MPEP regarding allegations of fact related to the date of conception or reduction to practice is also set forth:

"A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131."

MPEP §715.07, *Facts and Documentary Evidence; I. General Requirements*, Rev. 6, 2007 (p. 700-283).

There is no bright line test that an inventor must follow in providing corroboration of his testimony of conception. See *Kridl v. McCormick*, 105 F.3d 1446, 1450, 41 USPQ2d 1686, 1689 (Fed.Cir.1997). A "rule of reason" analysis is used to determine whether an inventor's testimony is sufficiently corroborated, in which "an evaluation of *all* pertinent evidence must be made so that a sound determination of the credibility of the

inventor's story may be reached." *Price v. Symsek*, 988 F.2d 1187, 1195, 26 USPQ2d 1031, 1037 (Fed.Cir.1993) (*emphasis in original*).

In the present application, as will be clear from the remarks below and the declarations and exhibits included with this response, the showing is far greater than "a general allegation." Indeed, Applicant and his attorneys are firmly of the opinion that the additional showing submitted with this Request for Reconsideration, including the Peterson Declaration of March 10, 2009, the Catalano Declaration of March 10, 2009, the van Eyck Declaration and the d'Oelsnitz Declaration constitute a far greater evidentiary showing that is required under the law and governing precedent.

The Examiner's Function in Reviewing a Showing Under 37 C.F.R. § 1.131

In *Ex Parte McGuckian*, 202 USPQ 398 (PTO Bd. App. 1976), it was stated that "A 131 showing is presented and must be evaluated completely ex parte. It is neither the Examiner's function nor [the Board of Patent Appeals] function under such circumstances to divine the role if any played by someone who is a complete stranger to the proceeding." Therefore, if the inventor and corroborating witnesses make declarations or statements submitted under 18 U.S.C. § 1001, the Examiner is required to construe these statements at face value as true and accurate factual statements.

Comparison of the Claims to the Declarations of the Inventor and the Corroborating Witnesses

Kumar does not constitute prior art with respect to the elements, steps, and features the claims of the present invention. Applicant respectfully submits that the prior invention of each and every limitation of claims 1 and 12 of the instant application is fully supported by the Peterson Declaration of March 10, 2009, the corroborating Catalano Declaration of March 10, 2009, the corroborating van Eyck Declaration, and the corroborating d'Oelsnitz Declaration.

These declarations constitute clear and convincing evidence and satisfy Applicant's burden of proof to establish the facts and circumstances demonstrating that Gary E. Peterson was in possession of the invention as claimed in the present application, and that the system and method as claimed was actually reduced to practice no later than

December 12, 2002. This is prior to the December 16, 2002 earliest priority date of the Kumar reference.

Applicant also respectfully maintains that facts were set forth in the declarations previously submitted on June 24, 2008 that established that not only was the invention of claims 1 and 12 of the instant application conceived before the December 16, 2002, the filing date of the provisional application from which the Kumar reference claims priority, but also established that the system and method claimed were actually reduced to practice no later than December 12, 2002.

Independent Claim 1

With respect to independent claim 1 of the instant application, the evidence establishes that the interactive risk management system and all of its elements were included in the operable program that was actually reduced to practice no later than the demonstration to a prospective customer that took place on December 12, 2002. In particular, the system comprised a computer including a processor, an input device, a display for displaying a graphic user interface including a browser and a memory. (See the Peterson Declaration of March 10, 2009, paragraphs 12 and 17; the Peterson Declaration of June 23, 2008, paragraph 6 (pp. 2-3); the Catalano Declaration of March 10, 2009, paragraphs 9 and 20; and the Catalano Declaration of June 23, 2008, paragraph 5.

In addition, the system included a mapping of a plurality of processes and at least one risk message associated with at least one of the plurality of processes stored in the memory. (See the Peterson Declaration of March 10, 2009, paragraphs 12, 15, 18 and 19; the Peterson Declaration of June 23, 2008, paragraph 6 (pp. 2-3); the Catalano Declaration of March 10, 2009, paragraphs 12-15 and 20; the Catalano Declaration of June 23, 2008, paragraph 5, and its accompanying RPC Exhibits A-1 through A-7).

In the system that was actually reduced to practice no later than December 12, 2002, the processor, in response to user selections through the input device, displayed to the user through the browser the mapping of the plurality of processes, with each of a set of the displayed processes having an associated user actuatable display region. (See the Peterson Declaration of March 10, 2009, paragraphs 15, 18 and 19; the Peterson

Declaration of June 23, 2008, paragraphs 6 (pp. 2-3) and 10; the Catalano Declaration of March 10, 2009, paragraphs 12-15 and 20; the Catalano Declaration of June 23, 2008, paragraphs 5 and 10, including its accompanying RPC Exhibits A-1 through A-7).

Finally, the system that was actually reduced to practice clearly included the features whereby the processor, in response to user actuation of an actuatable display region of a selected process, at least one risk message associated with the selected process is displayed to the user through the browser, thereby allowing the user to gain information about the selected process and its associated risks. (See the Peterson Declaration of March 10, 2009, paragraph 15; the Peterson Declaration of June 23, 2008, paragraphs 6 (pp. 2-3) and 10; the Catalano Declaration of March 10, 2009, paragraphs 14-15 and 20; the Catalano Declaration of June 23, 2008, paragraphs 5 and 10, including its accompanying RPC Exhibits A-6 and A-7).

The fact that this system including these elements was actually reduced to practice no later than December 12, 2002 is clearly and unequivocally stated in the declarations submitted with this Request. (See the Peterson Declaration of March 10, 2009, paragraphs 17-19; the Peterson Declaration of June 23, 2008, paragraph 10; the Catalano Declaration of March 10, 2009, paragraphs 10 and 18-21; the Catalano Declaration of June 23, 2008, paragraph 10; the van Eyck Declaration, paragraphs 8-12; and the d'Oelsnitz Declaration, paragraph 4). In addition, clear and unequivocal evidence that the meeting occurred prior to December 16, 2002 was provided in Exhibit 2 of the Peterson Declaration of December 19, 2007. The occurrence of the meeting on December 12, 2002, i.e., before the December 16, 2002 effective date of the Kumar reference, is corroborated in the d'Oelsnitz Declaration (paragraph 5, referring to Exhibit 1 of the d'Oelsnitz Declaration, which includes Mr. d'Oelsnitz' signature). Note that this letter, although dated December 17, 2002, refers to the meeting "last week." Since December 17, 2002 was a Tuesday, "last week" necessarily refers to a date prior to the earliest priority date of the Kumar reference on December 16, 2002.

Independent Claim 12

With respect to independent claim 12 of the present application, the evidence establishes that the interactive risk management method was actually reduced to practice

in the operable program no later than the demonstration to a prospective customer that took place on December 12, 2002. In particular, the method included providing a computer including a processor, an input device, a display and a memory, and displaying a graphic user interface including a browser and a memory. (See the Peterson Declaration of March 10, 2009, paragraphs 12 and 17; the Peterson Declaration of June 23, 2008, paragraph 6 (pp. 2-3); the Catalano Declaration of March 10, 2009, paragraphs 9 and 20; the Catalano Declaration of June 23, 2008, paragraph 5).

In addition, the method included storing in the memory a mapping of a plurality of processes and at least one risk message associated with at least one of the plurality of processes stored in the memory. (See the Peterson Declaration of March 10, 2009, paragraphs 12, 15, 18 and 19; the Peterson Declaration of June 23, 2008, paragraph 6 (pp. 2-3); the Catalano Declaration of March 10, 2009, paragraphs 12-15 and 20; the Catalano Declaration of June 23, 2008, paragraph 5, including its accompanying RPC Exhibits A-1 through A-7).

In the method that was actually reduced to practice, user command signals were received by the processor through the input device, and the mapping of the plurality of processes was displayed to the user through the browser, with each of a set of the displayed processes having an associated user actuatable display region. (See the Peterson Declaration of March 10, 2009, paragraphs 15, 18 and 19; the Peterson Declaration of June 23, 2008, paragraphs 6 (pp. 2-3) and 10; the Catalano Declaration of March 10, 2009, paragraphs 12-15 and 20; the Catalano Declaration of June 23, 2008, paragraphs 5 and 10, including its accompanying RPC Exhibits A-1 through A-7).

Finally, the method that was actually reduced to practice clearly included the step whereby the processor received signals corresponding to user actuation of an actuatable display region of a selected process, and at least one risk message associated with the selected process was displayed to the user through the browser, thereby allowing the user to gain information about the selected process and its associated risks. (See the Peterson Declaration of March 10, 2009, paragraph 15; the Peterson Declaration of June 23, 2008, paragraphs 6 (pp. 2-3) and 10; the Catalano Declaration of March 10, 2009, paragraphs 14-15 and 20; the Catalano Declaration of June 23, 2008, paragraphs 5 and 10, including its accompanying RPC Exhibits A-6 and A-7).

The fact that this method including these steps was actually reduced to practice no later than December 12, 2002 is clearly and unequivocally stated in the declarations submitted with this Request. (See the Peterson Declaration of March 10, 2009, paragraphs 17-19; the Peterson Declaration of June 23, 2008, paragraph 10; the Catalano Declaration of March 10, 2009, paragraphs 10 and 18-21; the Catalano Declaration of June 23, 2008, paragraph 10; the van Eyck Declaration, paragraphs 8-12; and the d'Oelsnitz Declaration, paragraph 4). In addition, clear and unequivocal evidence that the meeting occurred prior to December 16, 2002 was provided in Exhibit 2 of the Peterson Declaration of December 19, 2007. The occurrence of the meeting on December 12, 2002, i.e., before the December 16, 2002 effective date of the Kumar reference, is corroborated in the d'Oelsnitz Declaration (paragraph 5, referring to Exhibit 1 of the d'Oelsnitz Declaration, which includes Mr. d'Oelsnitz' signature). Note that this letter, although dated December 17, 2002, refers to the meeting "last week." Since December 17, 2002 was a Tuesday, "last week" necessarily refers to a date prior to the earliest priority date of the Kumar reference on December 16, 2002.

CONCLUSION

Based on the evidence previously submitted and the additional evidence filed with this Response and discussed in detail above, Applicant submits that the date of invention of the claims of the instant application is prior to that of the Kumar reference, and therefore Kumar is not citable as prior art. Therefore, independent claim 1 and its dependent claims 2-11, and independent claim 12 and its dependent claims 13-20, are patentable over the art of record.

All issues having been addressed, a favorable outcome on the merits is earnestly solicited. To resolve any questions or concerns that may remain, it is requested that the undersigned be contacted to discuss such matters in an interview.

Please charge any fees which may be due and which have not been submitted herewith to this firm's Deposit Account No. 01-0035.

Respectfully submitted,



Ralph J. Crispino, Reg. No. 46,144
Attorney for Applicant

Abelman Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017
Tel. (212) 949-9022